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| EXAMINER |
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HU, JINSONG

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| ART UNIT | PAPER NUMBER |
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2154

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/432,069

Applicant(s)

SANTAMAKI ET AL.

Examiner

Jinsong Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-28 are presented for examination. Claims 21-28 are newly added claims.
2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show texts or labels in some boxes of Fig. 1, 4 and 6-7 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. See MPEP 608.02(d). Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweet et al. (US 6,415,278 B1) in view of Warnock et al. (US 5,634,064).
5. As per claims 1, 8 and 11-12, Sweet teaches the invention substantially as claimed including an electronic book (e-book) system [col. 3, line 60 – col. 4, line 5], comprising:

a private network [i.e., connection between 140 and 144 on Fig. 11]; a central server [144, Fig. 11] connected to said private network, which stores a collection of electronic documents [144, Fig. 11; col. 8, lines 9-10];

an e-book server [100, Fig. 11] which stores an electronic document selected from said central server converted in an e-book format [i.e., PDF format][col. 7, lines 8-14; col. 8, lines 27-35] for downloading to a e-book terminal [col. 8, lines 10-15]; and

a host computer [140, Fig. 11] connected to said private network, which selects the electronic document from said central server [col. 8, lines 9-11], and transfer the selected electronic document from said central server for storage at the e-book server in an e-book format for later downloading to an e-book terminal [col. 8, lines 24-44].

6. Sweet does not specifically teach the step of using a print function of an operating system to transfer the selected electronic file for storage as an e-book format from the central server to the e-book server.

7. However, Warnock on the other hand teaches the step of using a print function of an operating system to transfer the selected electronic file for storage as an e-book format [i.e., PDF format] from the central server to the e-book server [i.e., PDF printer driver][col. 5, lines 51-62]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Warnock's file transmitting step in Sweet's system because it is a well-known PDF file transmitting or processing method in the art [Warnock, col., 5, lines 59-62].

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8. Sweet does not specifically the e-book terminal is connected to the e-book server via a public network. However, Warnock on the other hand teaches that the e-book terminal is connected to the e-book server via a public network [58, 66, Fig. 3; col. 5, lines 22 –30]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Warnock's remote transmitting step in Sweet's system because doing would improve the capability of Sweet's system by allowing the e-book server provide service to more users. One of ordinary skill in the art would have been motivated to modify Sweet's system with Warnock's transmitting step to improve the performance of the system.

9. As per claims 2-3 and 5, Warnock teaches the step of using a print function of an operating system to transfer the selected electronic file from the central server to the e-book server [col. 5, lines 51-62].

10. As per claim 4, Sweet teaches the step of converting data reflecting the selected electronic document into an e-book format for storage at said e-book server [col. 12, lines 40-46].

11. As per claims 6 and 7, Warnock teaches the step of emulating e-book server as a network printer [col. 5, lines 51-62].

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12. As per claim 9, Sweet and Warnock teaches the invention substantially as claimed in claim 1. Both references do not specifically teach that the network including LAN, POTS etc. network. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made utilizing these network in Sweet's system because all of them are well-known data communication networks in the art.

13. As per claim 10, Sweet teaches that the e-book comprises an electronic module which provides a central processing unit (CPU), a BIOS read-only-memory (ROM), and a random-access-memory (RAM), a display and a display controller, a power unit which provides power supply to said e-book terminal; an read-only-memory (ROM); a communication interface; and a security unit which provides overall security to said e-book terminal [col. 8, lines 6-7 & 10-20].

14. As per claims 13-20, since they present the same limitations as claims 1-9 from two different perspectives [i.e., the server and the client, respectively], they are rejected for the same bases as claims 1-9 above.

15. As per claims 21-22 and 27, Sweet teaches the invention substantially as claimed including an electronic book (e-book) system [col. 3, line 60 – col. 4, line 5], comprising:

a first network [i.e., connection between 140 and 144 on Fig. 11];

a e-book terminal [100, Fig. 11];

a host terminal [140, Fig. 11];

a central server [144, Fig. 11] connected to said private network, which stores a collection of electronic documents [144, Fig. 11; col. 8, lines 9-10];

an e-book server [100, Fig. 11] which stores an electronic document selected from said central server converted in an e-book format [i.e., PDF format][col. 7, lines 8-14; col. 8, lines 27-35] for later downloading to a e-book terminal [col. 8, lines 10-15];

wherein said host computer connected to first network [col. 8, lines 9-11] for transferring the selected electronic document from said central server for storage in an e-book format at said e-book server for later downloading to a e-book terminal [col. 8, lines 24-44].

16. Sweet does not specifically teach the step of providing a print function of an operating system through emulation software for transferring the selected electronic file for storage as an e-book format from the central server to the e-book server.

17. However, Warnock on the other hand teaches the step of using a print function of an operating system through emulation software for transferring the selected electronic file for storage as an e-book format [i.e., PDF format] from the central server to the e-book server [i.e., PDF printer driver][col. 5, lines 51-62]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Warnock's file transmitting step in Sweet's system because it is a well-known PDF file transmitting or processing method in the art [Warnock, col., 5, lines 59-62].

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18. Sweet does not specifically the e-book terminal is connected to the e-book server via a second network [i.e., public network]. However, Warnock on the other hand teaches that the e-book terminal is connected to the e-book server via a public network [58, 66, Fig. 3; col. 5, lines 22 –30]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Warnock's remote transmitting step in Sweet's system because doing would improve the capability of Sweet's system by allowing the e-book server provide service to more users. One of ordinary skill in the art would have been motivated to modify Sweet's system with Warnock's transmitting step to improve the performance of the system.

19. As per claims 23 and 25, Warnock teaches the step of using a print function of an operating system to transfer the selected electronic file from the central server to the e-book server [col. 5, lines 51-62].

20. As per claim 24, Sweet teaches the step of converting data reflecting the selected electronic document into an e-book format for storage at said e-book server [col. 12, lines 40-46].

21. As per claim 26, Warnock teaches the step of emulating e-book server as a network printer [col. 5, lines 51-62].

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22. As per claim 28, Sweet teaches that the e-book comprises an electronic module which provides a central processing unit (CPU), a BIOS read-only-memory (ROM), and a random-access-memory (RAM), a display and a display controller, a power unit which provides power supply to said e-book terminal; an read-only-memory (ROM); a communication interface; and a security unit which provides overall security to said e-book terminal [col. 8, lines 6-7 & 10-20].

Conclusion

23. Applicant's arguments filed on 9/9/03 for claims 1-28 have been fully considered but they are not deemed to be persuasive.

24. In the remarks, applicant argued in substance that (1) Sweet does not teach an e-book server; (2) Sweet does not teaches a host computer; (3) Sweet does not teach a remote e-book terminal; (4) Sweet does not teach the step of advancing distributing electronic reading material by an e-book server; (5) Sweet and Warnock do not teach emulation software installed in one of the host computer for emulating the e-book server as a network printer.

25. Examiner respectfully traverses applicant's remarks:

A. As to point (1), applicant fails to consider the teaching of Sweet for integrating the retrieved documents from the web server into a PDF file [i.e., e-book format] in the element 100 of Fig. 11 [col. 8, lines 32-35]. Such function implemented by

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the element 100 is the same function of e-book server as applicant claimed. Thus, Sweet does teach an e-book server as applicant claimed.

B. As to point (2), applicant fails to consider the teaching of Sweet for transferring the selected electronic documents from central server for storage at the e-book server in an e-book format [col. 8, lines 27-35], such function is implemented by element 140 in Sweet's system. Thus, Sweet does teach a host computer as applicant claimed.

C. As to points (3) and (4), applicant fails to consider the teaching of Sweet for an e-book terminal [i.e., user's computer 100]. In Sweet's system, e-book server and e-book terminal are integrated in the same device. Although the e-book terminal in Sweet's system is not separated from the e-book server, it is obvious to the person with skill in the art to make any modification without departing from the spirit and scope of the reference of Sweet [see explanation in corresponding paragraph in this Action].

D. As to point (4), applicant fails to consider the teaching of Sweet for viewing PDF file [i.e., e-book format] converted by web page integrator from the documents received from web server on user's computer, the user's PDF viewer needs retrieving the required PDF documents from the e-book server even they are sitting in the same device. Thus, Sweet does teach the step of advancing distributing electronic reading material by an e-book server.

E. As to point (5), in the previous Office Action, the Examiner specified that the reference of Sweet does not teach emulation software for emulating the e-book server as a network printer. However, Warnock teaches the emulation software [i.e.,

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Aldus Personal Press 2.0] installed in the host computer [12 of Fig. 1 in Warnock's system] to emulate the e-book server [i.e., PDF printer driver in Warnock's system] as a network printer for distributing [printing] the PDF document [col. 5, lines 22-30 & 54-62]. Thus, Warnock does teach emulation software installed in one of the host computer for emulating the e-book server as a network printer.

Accordingly, both Sweet and Warnock are relevant prior art references.

26. THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax number for this Group 2100 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

October 16, 2003


ZARNI MAUNG
PRIMARY EXAMINER